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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,663

06/01/2007

Hideo Kobayashi

Q96644

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23373 7590 03/17/2011
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EXAMINER

MACARTHUR, SYLVIA

ART UNIT

PAPER NUMBER

1716

NOTIFICATION DATE

DELIVERY MODE

03/17/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/590,663

Applicant(s)

KOBAYASHI, HIDEO

Examiner

Sylvia R. MacArthur

Art Unit

1716

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection. It is also noted that in the Remarks page 8 under Support for Amendments, applicant asserts that claim 1 has been amended to define that the holding structure 9 as containing plural member 5, however the claim does not state this. Note, that the claim only recites that the holding structure allow in-plane rotation. The prior art of Sumio (JP 2001-179163) anticipates claim 1 as it teaches a rotary table 4 which supports the substrate W and rotates. Regarding claims 2-8 and new claims 9-13 the rejections are as follows:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,5,8,9,11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sumio (JP 2001-179163).

5. Sumio teaches a rotary coater and rotary coating method. Note that though the apparatus and method are recited as being intended for coating the apparatus and method are also capable of being used in the unnecessary film removal apparatus and with the type of substrate recited in

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the claims as the apparatus is what it is and not what it does. The apparatus of Sumio is inherently capable of treating the type of substrate recited in the claims. The apparatus of Sumio features a substrate holding structure (rotary stage 4), a chemical solution supply member (see elements 28,22,27,34, and 25), and a shield member 20 (top portion) with clearance 23 and guide member 51 (also anticipated by the side portions of the shield member) see Fig. 6. See also section [001] as a discussion of removing a thin film. See also section [0010] and [0016] wherein it is taught that it is known to dissolve or remove a thin film.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 6,7, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumio in view of Mitsusaki (KR 2003-0020058).

The teachings of Sumio are discussed above. Sumio fails to teach distance adjusting members and clearance adjusting member.

The prior art of Mitsusaki teaches a method and device for removing an unnecessary film from the substrate (10). The apparatus of Mitsusaki teaches a spinning table 20, a cover member 30, nozzles 40, 40a, and a guide member (sidewall part 35). In Mitsusaki, it is discussed that there is a distance determining member which adjusts a distance between a shield member and a substrate. See both the distance between the

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guide member and substrate is adjustable (d1 and d2) and the distance between the shield member and substrate(ds) are adjustable. The shape, number, and position of the distance adjusting members and shield member are matters of design choice that could have been determined without undue experimentation barring a showing of criticality. See the last three paragraphs of page 8 wherein the gap is discussed as being adjustable. Thus, it would have been obvious for one of ordinary skill in the art at the time of the claimed invention to combine the teachings of Sumio and Mitusaki and to design the shield member and distance determining member as recited as a matter of obvious design choice.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sylvia R. MacArthur whose telephone number is 571-272-1438. The examiner can normally be reached on M-Th during the hours of 8 a.m. and 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on 571-272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 12, 2011

/Sylvia R MacArthur/
Primary Examiner, Art Unit 1716